

No. 20267

In The

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Vol 3367

United States Court of Appeals

FOR THE NINTH CIRCUIT

SANTA ANITA MFG. CORP., a California corporation,
Appellant,

vs.

MAX J. LUGASH and MAXON INDUSTRIES, INC., a California corporation,

Appellees-Cross Appellants,

vs.

SANTA ANITA MFG. CORP., a California corporation,
Cross Appellee.

CROSS APPELLEE'S BRIEF.

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of

FILED

JUL 2 1 1966

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CROSS APPELLEE'S BRIEF.

Jurisdiction.

The jurisdiction of the District Court and of this Court of Appeals is admitted, this appeal being limited to the sole issue of the validity of Lugash patent '196.

Statement of the Case.

The issues of validity and infringement of Lugash '227 [Find. of Fact 6-30] and the District Court's errors with respect thereto are the subject of defendant's appeal (App. Op. Br.) which will not be duplicated here. The validity of the first Lugash '227 patent is not in issue in this appeal. This appeal concerns only Findings of Fact 31 through 35a and Con-

clusions of Law G and H. The plaintiffs' (Cross Appellants here) many references to the other findings relating to the '227 patent (Op. Br. of Cross App. pp. 2-7) are irrelevant to this appeal.

A. The '196 Patent.

"The second patent in suit, Lugash '196, is directed to the load elevator of the first Lugash patent with a unitary construction which embodies all associated working parts of the device being mounted on a main frame and attachable to the vehicle as a unit and which allows clearance by the platform of the hydraulic cylinder in the folded position." [Undisputed Find. of Fact 31, Vol. 1, p. 671].

In the prior Lugash '227 patent [Ex. 1], a main frame 3, 3 was bolted to the vehicle frame members F, F to support the power components (electric motor 32, worm gear speed reducer 18 and winch drums 26), as well as the lifting arms or linkages 42, 44 [Ex. 1, Col. 2, lines 6-61]. The winch drum cables 57 were run over pulleys 58, 61 which were mounted to the vehicle bed [Ex. 1, Fig. 1]. In the '227 alternative embodiment of Figure 9, hydraulic cylinders 70, 70 were provided for raising the lifting arms, the upper ends of the cylinders being connected to the vehicle body sill S. The '227 loader, therefore, was not entirely unitary in its construction since it could not be attached to the vehicle by only the assembling of the main frame structure 3, 3 to the truck frame members F, F.

In the '196 patent [Exs. 2 and B] a main frame member 2 is attachable to the vehicle frame members F, F by brackets 4, 4 (Figs. 1-3). Main frame 2 mounts the hydraulic cylinder 27 (on A-frame 28), lifting arms

or linkages 8, 9 and all of the power components (Fig. 7) including the electric motor 33, hydraulic fluid pump 32 and reservoir 31 [Ex. 2, Col. 3, lines 45-49]. The objects and disclosure of the '196 patent over those of the '227 patent are in the provision of a single hydraulic cylinder and a unitary construction (Gabriel, Vol. 3, pp. 649-651). Plaintiffs' patent expert, Mr. Comstock, summarized the alleged improvement of '196 as:

“A. The improvement, as I testified previously, is in making a load-lifting device of this type completely unitary so that it could be mounted at a single point on the vehicle, which would provide the proper alignment of all the operating parts, both with respect to each other and with respect to the vehicle.” (Comstock, Vol. 3, p. 252).

Because of the size of platform employed and the orientation of the hydraulic cylinder employed by Lugash in the '196 patent exemplary embodiment, he created an interference between the platform and hydraulic cylinder when the platform is moved into its folded position [Ex. 2, Col. 3, lines 19-23].

“Q. And in '196 Lugash clearly did not want the platform 16 to engage the cylinder 26, as he provided a slot 17, is that correct? A. That is right.” (Comstock, Vol. 3, p. 252).

No such clearance problem ever occurred in defendant's loaders [Exs. 4 and AP] wherein the platform merely folds back against and rests on the hydraulic cylinder [Exs. 5 and AP]. The complete fabrication of a problem of clearance by Lugash '196 is demonstrated by plaintiffs' own current models [Ex. 21] which elim-

inate the clearance notch 17 [Ex. 2] by merely relocating the hydraulic cylinder (note that the models shown on the covers of both brochures in Exhibit 21 mount the electric-hydraulic power unit to the truck bed, not the main frame, and do not even employ the patented unitary construction).

The Trial Court was fully advised as to the alleged improvements of the '196 patent over the '227 patent. The unitary construction and asserted clearance problem were specifically considered by the District Court in its Findings of Fact 31 through 33 [Vol. I, p. 671]. Plaintiffs do not allege error in these findings (Specification of Errors, Op. Br. of Cross App., pp. 10-11) and therefore have admitted on this appeal that the District Court correctly summarized the '196 patent [Find. of Fact 31], found the construction to be old [Find. of Fact 32], and found that no substantial difference exists in the problems of making the '196 loader unitary from that of the prior art including defendant's own prior loaders [Find. of Fact 33].

Defendant here contends that the Trial Court was compelled to hold patent '196 invalid on the facts and the authorities hereafter discussed.

**B. The Trial Court's Grounds for Holding the
'196 Patent Invalid.**

Plaintiffs incorrectly summarize the Court's Findings into a single ground for holding Lugash '196 invalid (Op. Br. of Cross App., p. 2). In the Trial Court's Findings of Fact 32 and 33 [Vol. 1, p. 671; not disputed by plaintiffs], the Trial Court found that the unitary construction of truck loaders adopted by Lugash was old in the art (including prior models of de-

fendant's own unitary truck loaders made and sold by defendant prior to the filing of the '196 patent) and that there is no substantial difference between the problem of providing plaintiffs' fold-over platform device with a unitary construction from that solved by prior art unitary devices, patents and defendant's own prior models which mounted to the truck frame as an integral unit. From this, the Trial Court concluded that the provision of unitary construction in the '196 patent was obvious to one skilled in the art at the time of plaintiffs' purported invention [Find. of Fact 35, Vol. 1, p. 672] and concluded that the patent was therefore invalid under the provisions of Title 35, U.S.C. §103 [Concl. of Law G, Vol. 1, p. 674].

The Trial Court also found that the '196 patent claims are invalid for claiming a combination of old elements which perform no novel or unusual functions in the combination not performed by them out of the combination [Undisputed Find. of Fact 33, Vol. 1, p. 671 and Concl. of Law G, Vol. 1, p. 674].

As for a third ground for holding the '196 patent invalid, the Trial Court found that the claims of patent '196 incorporate "the claims of Lugash '227 in combination with other disclosures of prior art as exemplified by defendant's Exs. AN-1, AN-4, AN-5, AN-7 and AN-8" [Find. of Fact 34, Vol. 1, p. 671]. The Trial Court considered the asserted "clearance problem" of the platform and the hydraulic cylinder and found '196 to be merely a variant of the claimed subject matter of Lugash '227 which would be obvious to one skilled in the art [Find. of Fact 35a, Vol. 1, p. 672] and correctly concluded from Findings of Fact 34 and 35a that Lu-

gash '196 is invalid as a matter of law, 35 U.S.C. §103, because "it attempts to claim the claimed subject matter of the prior Lugash patent '227 in combination with other disclosures of the prior art." [Concl. of Law G, Vol. 1, p. 674].

The alleged improvement of the '196 patent is an obvious adaptation of old unitary construction for truck loaders to plaintiffs' device which does not produce any new or different function, nor obtain an unexpected result in the '196 claimed combinations than that obtained by it in the prior art.

ARGUMENT.

I.

Plaintiffs Fail to Particularly Point Out Wherein the Findings of Fact Are Unsupported by Substantial Evidence.

Plaintiffs have failed to point out with particularity wherein the Findings of Fact 34 through 35a are asserted to be in error in their Specification of Errors (Op. Br. Cross App. pp. 10-11). Plaintiffs only express dissatisfaction with the District Court's findings and conclusions (Specification of Errors 1-3 and 7) without actually informing this Court wherein the findings are in error, complain that the District Court did not make findings favorable to plaintiffs (Specification of Errors 4 through 6) and attempt to specify error as to the issue of infringement (Specification of Error 8) which is admittedly not before this Court on this appeal. Plaintiffs never point out in their brief wherein any of the Findings of Fact of the Trial Court are clearly erroneous because unsupported by any substantial evidence or are contrary to the weight of the evidence, but rather seek to have this Court reject the District Court's conclusions based upon its findings and accept plaintiffs' contrived new result that the patented loader may be positioned beneath the vehicle "at any desired location".

"It is not our function to re-evaluate the evidence presented below. We cannot substitute our judgment for the first-hand evaluation made by the

trier of fact. * * * Our task, rather, is to determine if there exists evidence of substance to support the Findings of Fact of the Trial Court. Thus, it does not aid appellant's position on review to merely extract that evidence presented which supports its position; rather it must additionally demonstrate that no substantial evidence was presented which supports the District Court's findings in favor of appellee."

Cataphote Corporation v. DeSoto Chemical Coatings, Inc. (9th Cir., 1966), 356 F. 2d 24, 26.

Findings of Fact 31 through 33 are not specified as being erroneous. The District Court's conclusion of patent invalidity [Concl. of Law G] is supported by these Findings standing alone.

While the burden is upon plaintiffs to show that the findings are clearly erroneous and not supported by substantial evidence, defendant will hereinafter point out wherein the findings are supported by more than substantial evidence and wherein plaintiffs' assertions that the Trial Court incorrectly applied principles of law are in error.

In considering the patentability of the '196 patent, admittedly only an alleged improvement over the '227 patent, it should be kept in mind that:

"Innovation, advancement and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of . . . useful arts.' This is the *standard* expressed in the Constitution and it may not be ignored. And it is in

this light that patent 'validity requires reference to a standard written into the Constitution.' *A. & P. Tea Co. v. Supermarket Corp.*, *supra*, at 154."

Graham v. John Deere Company of Kansas City, U.S., 86 S. Ct. 684, 688 (1966).

A review of the file history before the Patent Office [Ex. B] of the '196 patent discloses that a myriad of old elements including motors, pumps and even conduits and switches to be mounted upon the main frame were added to the claims in order to obtain the issuance of this patent by the Patent Office. While the '196 claimed combinations apparently passed the Patent Office standard, it did not meet with the aforementioned Constitutional standard of adding to the sum of useful knowledge correctly applied by the District Court.

"We have observed a notorious difference between the standards applied by the Patent Office and by the Courts. While many reasons can be adduced to explain the discrepancy, one may well be the free reign often exercised by Examiners in their use of the concept of 'invention.'"

Graham v. John Deere Company of Kansas City, *supra*, 86 S. Ct. at 694.

II.

Plaintiffs Attempt to Create a New Result Out of Mere Verbiage.

Plaintiffs are required to advise this Court exactly what the purported invention of the second Lugash patent '196 is supposed to be. Their burden becomes onerous since plaintiffs admit:

“All prior loaders have a load platform, lifting arms, a supporting framework, and power means for raising and lowering the platform. In all of these, each of the parts performs its old functions, i.e., the platform supports the load, the lifting arms raise and lower the platform, the framework provides a base for the device, and the power means raises and lowers the load. All are old and are applied to perform their old functions * * *” (Op. Br. of Cross App. p. 13).

This is one of the few correct statements in plaintiffs' brief, but it is incomplete since prior art also convincingly shows that the loading platform was hinged at a connection to the lifting arms, and could be manually pivoted down (to allow dock loading) or, at the discretion of the user, it could be pivoted in an opposite direction and when in the vertical position act as a tailgate or closure, or pivoted even further in the opposite direction so as to assume a folded position. All this was old in the prior art [Exs. AD, E-G, pp. 12-13; Roberts '187, Ex. D; Novotney '403, Ex. C; Peters '577, Ex. C; Narvestad '529, Ex. C; Jester '243, Ex. D; Ducondu '011 and '473, Ex. D; Exs. AN-1 through 11, App. Op. Br.).

So plaintiffs finally state that their purported invention or new result of this old combination of elements is that it:

“* * * achieves a power loader attachable as a unit to any desired position under a truck.” (Op. Br. of Cross App. p. 15).

Plaintiffs repeat this phrase about twenty times in their brief, as if they hoped it had some mystical effect on your Honors. Let us see if this phrase answers the three prerequisites of invention: novelty, utility and non-obviousness as required by statutory law (35 U.S.C. §§ 101, 102, and 103).

A. “A Power Loader.”

A power loader and every element thereof in the same relationship for the same purpose is admittedly old and well-known in the prior art. Plaintiffs’ own admission quoted above coupled with the additional prior art which it ignores, convincingly shows that there is nothing novel in a power loader whether the platform hinges one way or another. Therefore, this portion of the mystic phrase cannot define anything patentable.

B. “Attachable as a Unit.”

Making a power loader as a unit was not first conceived by Lugash. The Trial Court had correctly found that the prior art showed power loaders attachable as a unit.

“The Trial Court felt that the non-cited art mentioned in Finding 35 was more pertinent than that considered by the Examiner in the Patent Office simply because Messick ’923, Wood ’540, and the defendant’s prior models mentioned therein all have the feature of mounting the complete power system on a main supporting framework. Specifically, in the cases of Messick and Wood ’540 they mount

the pump, motor and reservoir on the main framework, along with the hydraulic cylinder.” (Op. Br. of Cross App. pp. 31, 32).

Even on plaintiffs’ own argument it is clear that the making of an assembly from the same old elements into a unit capable of being attached to a truck is not new. The making of assemblies and subassemblies to facilitate installation was a common, obvious expedient long before the Lugash application was filed [Wachter, Duis, Park, Messick, Wood ’540, Exs. C and D]. There can be no patentable invention in forming a unitized assembly. Making a thing in one piece where it had formerly been made of several pieces has been repeatedly held to be non-inventive. (See: *Deller’s Walker on Patents*, 2d Ed., Vol. 2, §118 and p. 282, fn. 1, 2).

C. “To Any Desired Location.”

A truck has a forward cab portion, it has sides and it has a back end. Some trucks and vans have single end doors, others have double end doors and others have side doors. Can this Court say that it is invention to exercise discretion in the placement of a power loader so that it conforms to the location of a loading door or opening? It is obvious to attach an old assembly of elements wherever you desire it to perform its old function of raising and lowering loads.

Lugash did not invent the side loader concept (Shadbolt patent ’822, Fig. 1, p. 1, Col. 2, lines 97-100). The prior unitary construction of commercial loaders such as Daybrook (Wood ’540 patent; Vogel, Vol. III, pp. 391-392) as well as that of the Anthony Company loaders of Exhibit AC (Wachter, Duis and Park; Vogel, Vol. III, pp. 405-412), relied upon by the

District Court as showing unitary construction to be old [Find. of Fact 32, Vol. I, p. 671], have been employed as side loaders mounted under the vehicle bed [Exs. E-G, p. 5 and AC, p. 4]. These prior unitary construction loaders were not only mounted as side and rear loaders on vehicles but were, because of their main frame unitary construction, susceptible of being mounted "upon any base or support" [Duis '491, Col. 2, line 27, Ex. D; Wachter '221, p. 1, Col. 2, lines 35-36, Ex. C; and Park '770, Col. 2, line 32 and Col. 3, lines 12-18].

The claims of the Lugash '196 merely require a main frame member to which all associated parts are attached. It is from this main frame member that plaintiffs derive their theory that the loader can be attached *anywhere* beneath the vehicle bed. But this same construction and unitary mounting of powered loaders on a single main frame member is clearly found in the prior art of unitary loaders mounted at the rear or side of vehicles, beneath the vehicle bed, or *on any other support*.

D. "Under a Truck."

Where else would you attach a truck loader? No intelligent man would attach it to the cab or place a loader mechanism on the top surface of a truck bed where it would interfere with loading.

Plaintiffs' own definition of the purported "invention" and "new result" shows that no patentable invention exists in the secondary Lugash patent '196. Plaintiffs are "scraping the bottom of the barrel" when they are forced to advance such an untenable definition of the purported "new result." A new result is not ob-

tained by stating that the old device can be moved and attached as a unit in “any desired location” at the discretion of the purchaser. The device, no matter what its location, would still simply lift and lower loads. The patent laws cannot preclude intelligent men from using common sense. Patents cannot be sustained where they merely rely on semantics.

“It has been frequently held that a second patent must be for an invention separate and distinct from that claimed in a former patent and that *mere differences in the scope or language of the claims do not constitute a separate and distinct invention*. Miller v. Eagle Mfg. Co., 151 U.S. 186, 198, 14 S.Ct. 310, 38 L.Ed. 121; Caldwell v. Firestone Tire & Rubber Co., D.C., 13 F.2d 483, 488, affirmed 2 Cir., 23 F.2d 1000; Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 90 F. 732, 744.” (Emphasis added).

Richmond Screw Anchor Co. v. Umbach (7th Cir., 1949), 173 F. 2d 521, 526.

III.

The Purported “Clearance” Problem.

Being hard-pressed for an argument to sustain this secondary Lugash '196 patent, counsel for plaintiffs have indulged in “the discovery of a clearance problem” (Op. Br. of Cross App., p. 26, line 2). This non-existent “clearance problem” was apparently no problem to Lugash [who merely cut a notch 17 in the platform, Ex. 2, Fig. 2] but is rediscovered here by counsel for purposes of this case.

“* * * The discovery of the problem does not constitute invention, and if the device of Balfe in all its essential elements is covered by the disclosures

of Hill and Salesky with only such mechanical changes or improvements as would occur to one skilled in the art, when confronted with the particular problem, the creation of the device does not constitute invention.”

Detroit Gasket & Mfg. Co. v. Victor Mfg. & Gasket Co. (C.A. 7, 1940), 114 F. 2d 868, 872.

The only alleged improvement of Lugash '196 is in the making of the '227 loader as a unit attachment with one hydraulic cylinder rather than the two side mounted cylinders in the '227 patent (Gabriel, Vol. III, pp. 649-651). The provision of a single centrally located hydraulic cylinder 26 [Ex. 2, Fig. 3] in a powered loader in place of two side mounted cylinders 70 [Ex. 1, Fig. 9] was obvious to those skilled in the art from the commercially available Anthony Company loaders as shown in any of the Wachter '221, Novotney '424 or Duis '491 patents (Gabriel, Vol. III, pp. 652-658; Vogel, Vol. III, pp. 403-412).

Having thus positioned the hydraulic power cylinder in conventional manner between the lifting arms, as in the prior loaders Lugash was undoubtedly aware of (his son Murray became familiar with the Anthony tail-gate loaders *the day* his father started building the Tuk-A-Way loader, Vol. III, p. 313), Lugash merely provided a notch 17 in the platform so that he could retain its length only slightly less than the length of the lifting and lazy bars 8 and 9 [Ex. 1, Col. III, lines 19-23] without the platform hitting the hydraulic cylinder. In defendant's accused devices, the platform merely folds back against and lies *on* the hydraulic cylinder of defendant's prior unitary construction loader

[Ex. 5; Gabriel, Vol. III, pp. 683, 690, 724-725, 754, 757, 760]. If a clearance problem ever existed which had to be solved by the provision of a clearance notch in '196, defendant has not used the solution and it has been abandoned by plaintiffs in their modern "Tuk-A-Way" loader constructions which do not include notches [Ex. 21].

Plaintiffs now state that this "problem" was not previously known to the art and that no evidence was presented on any liftgate that had the parts arranged in a manner to permit inversion of a load platform "without interfering with the hydraulic cylinder" (Op. Br. of Cross App., p. 23). Inverting of the platform and raising of the lifting arms in any of the Novotney '403, Narvestad '529 (Figs. 5-7) or Jester '243 patents would not interfere with the operation of the power means. In defendant's loaders, the platform merely lies back on the cylinder without any clearance between the platform and cylinder and without any notches providing such clearance (Vogel, Vol. III, pp. 472-480, Gabriel, Vol. III, pp. 724-725, 754, 757-758). There is no clearance problem in providing an old unitary power loader with connections between the lifting arms and platform to allow the platform to fold backwardly against the cylinder. Defendant's prior unitary construction of its EB-1500 loader [Ex. X] is used in the accused Folda-Lift loaders [Exs. 4, 5] with merely the platform being hinged to allow it to fold back *against the cylinder*. If one does not want the platform to abut against the cylinder, he can simply cut a notch in the platform.

Certainly it would be obvious to anyone that to allow a hinged element (whether it is a platform, a panel or a trap door) to pivot beyond an obstruction (hydraulic

cylinder), you can either move the obstruction or cut a notch in the hinged panel. Lugash originally cut a notch 17 in the platform [Ex. 2, Fig. 3] and later merely moved the hydraulic cylinder to a more horizontal position so that it was not an obstruction [Ex. 21]. A carpenter often trims the edge of a hinged element (known as a door) to avoid a thick carpet and permit the door to close flush. Hinged covers for fuse and relay boxes often have a notch in them to avoid hitting a latch or hasp. These solutions are obvious to men of ordinary skill; they were taken care of in the past without fanfare.

It would be obvious to any handyman who has seen a folding chair that to fold a platform or seat into a small space it would be desirable to have the platform between the legs with in folded position, etc. Obviously, proportions, distances widths, etc. may vary — these are all matters of degree. The size of the cylinder may vary with the load you expect to carry on the loader; the level of the pivot point of the cylinder may be varied as well as the length of the lifting arms since truck beds are of different heights above ground. But these variations in degree are within the skill of the art. They do not rise to the dignity of invention.

“There is the old rule that one is not entitled to a patent who merely makes a change in form, proportion or degree, by substantially the same means even though the changes he makes produce better results.”

Kalich et al. v. Paterson Pacific Parchment Co.
(9th Cir., 1943), 137 F. 2d 649, 652.

When a farmer cut a notch in the edge of a trap door leading to the well, so as to permit the trap door to miss

the moving pump rod, he did not make an invention. He solved his "clearance problem" by the use of common sense. Common sense is not to be monopolized by plaintiffs under the guise of a patent.

"It may afford evidence of judgment and skill in the selection and adaptation of the materials in the manufacture of the instrument for the purposes intended, but nothing more."

Hotchkiss v. Greenwood, 52 U.S. 248, 266.

The inescapable fact is that there is nothing in the claims which inventively, non-obviously, distinguishes from the ordinary skill of the calling as shown by the prior art.

IV.

The Patent Statutes Do Not Discriminate Against Prior Knowledge.

Plaintiffs attempt to minimize some of the evidence relating to prior knowledge [as shown in patents in Exs. C and D] by alleging that those devices did not come into successful use in the trucking industry. Plaintiffs' allegations are untenable for the following reasons:

1. Prior knowledge may be expressed in the form of patents, texts or publications or evidence of personal knowledge and usage.
2. So-called paper patents are just as effective as anticipations as the most widely sold product of General Motors.

"Appellant attempts to minimize the teachings of the prior art patents by referring to them as 'paper art' which had not been put to commercial

use, manufactured or sold. This is irrelevant to the question whether the *disclosures* therein constituted anticipation. *Edward Valves, Inc. v. Cameron Iron Works, Inc.*, (5 Cir., 1961), 286 F.2d 933, 939; *Tillotson Manufacturing Co. v. Textron, Inc., Homelite*, (6 Cir., 1964), 337 F.2d 833, 837."

Mannix Co. Ltd. v. Healey (5 Cir., 1965), 341 F. 2d 1009, 1010.

"* * * The phrase, 'paper patent,' is a mere bit of rhetoric, usually employed as a makeweight by judges who wish to support the patent in suit, but are embarrassed by a reference, of an escape from which they are not too confident. It is a meaningless platitude."

Frank B. Killian & Company v. Allied Latex Corporation (2 Cir., 1951), 188 F. 2d 940, 942.

3. The patent statutes 35 U.S. Code §§ 101, 102 and 103 do not impose "successful use" limitations on what is prior knowledge. The patent in suit must be unobvious in the light of all prior knowledge. The Supreme Court stated:

"* * * It is also irrelevant that no one apparently chose to avail themselves of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search—a prudent and nowadays common preliminary to well organized research. *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U.S. 485 (1900)."

Graham v. John Deere Company of Kansas City, supra, 86 S. Ct. 684, 703 (1966).

Therefore, this Court cannot disregard prior patents which show invertible platforms and unitary loader assemblies even if these prior patents allegedly were not commercially exploited when they were invented.

V.

**'196 Unitary Construction Was Obvious
to One Skilled in the Art.**

The earliest date for Lugash '196 is its filing date, September 27, 1957. Contrary to plaintiffs' statement at page 5 of their Brief, there is no evidence of commercial production of the Tuk-A-Way loaders of patent '196 in early 1957 [Ex. D, the Depo. of Pltff. Lugash was never introduced into evidence].

The prior models of defendant's loader which were of a unitary construction referred to by the District Court in its Findings are exemplified by the prior EB-1200 model loader [Exs. N, O, S, Vol. III, p. 425; Ex. T, Vol. III, p. 427] and the same heavier constructed EB-1500 [Ex. X]. Defendant's EB-1500 FL loader of plaintiffs' Exhibit 4 (accused to be an infringement of Lugash '196) differs from defendant's prior unitarily constructed EB-1200 and EB-1500 loaders only in the hinging and size of the platform and the provision of a body spacer on the rear end of the truck (a non-claimed element) [Vogel, Vol. III, pp. 442-445].

In 1960, when defendant modified its existing unitary construction EB-1500 loader to obtain the EB-1500 FL loader, the inverting of the platform was a simple matter which did not require retooling nor changes major in character [Find. of Fact 13A, Vol. I, pp. 665-666]. In fact the photographs for both defendant's brochures, Exhibit 4 and Exhibit X, were

made of the same truck with merely the platforms being replaced [Vogel, Vol. III, pp. 442-445]. There was *no problem* in adapting the defendant's prior art unitary construction for tailgate loaders to the EB-1500 FL loader. The platform was merely made smaller and hinged so that it could fold back against the hydraulic cylinder [Ex. 5].

When Lugash mounted a single hydraulic cylinder centrally of the lifting arms on the main frame of the '196 patent [in the identical position as shown in Wachter patent 2,389,221, Ex. C, commercially available prior to Lugash '196 as the Anthony Liftgate, Ex. AC] he merely provided a simple notch 17 [Ex. 2, Fig. 2] so that the platform would invert back on the lifting linkage *without* hitting the cylinder stating:

“* * * It will also be noted that the length of the platform is only slightly less than the length of the lifting and lazy bars 8 and 9 and that the notch 17 in the platform provides the required clearance for the piston rod.” [Ex. 2, Col. 3, lines 20-23; Ex. E-V].

Subsequently, the platform notch was eliminated by Lugash by his merely relocating the hydraulic cylinder [Ex. 21].

The District Court correctly found that there is no substantial difference insofar as concerns the problem of unitary construction in the plaintiffs' Tuk-A-Way device including a fold-over platform moved to and from the out-of-the-way position of the truck bed and the problem of unitary construction of the devices in the prior art patents and in *defendant's prior models* [Undisputed Find. of Fact 33, Vol. I, p. 671]. There was no problem unsolved by the prior art. All Lugash

'196 accomplishes is the provision of the folding platform (claimed in '227) in the old unitary power loaders of the prior art.

“* * * The Scoggin invention, as limited by the Patent Office and accepted by Scoggin, rests upon exceedingly small and quite non-technical mechanical differences in a device which was old in the art. At the latest, those differences were rendered apparent in 1953 by the appearance of the Livingstone patent, and unsuccessful attempts to reach a solution to the problems confronting Scoggin made before that time became wholly irrelevant.

* * * To us, the limited claims of the Scoggin patent are clearly evident from the prior art as it stood at the time of the invention.”

Graham v. John Deere Company of Kansas City, supra, 86 S. Ct. 684, 703 (1966).

VI.

'196 Claims an Old Combination of Old Elements.

The claims of Lugash '196 are directed to the old combination of main frame member, parallel rule linkage means, load receiving platform hingedly mounted on a platform supporting member connected to the lower end of the linkage means and power means for raising and lowering the linkage means.

The Trial Court found and it is not disputed that the claims of patent '196 are directed to a combination of old elements which perform no novel or unusual functions in the combination not performed by them out of the combination [Undisputed Find. of Fact 33, Vol. I, p. 671].

Plaintiffs carefully have omitted directing the Appellate Court's attention to the actual claims of the '196 patent. These claims and the application of the prior art thereto are fully set forth in defendant's Exhibit AN. The Court's attention is directed thereto. For example, the Lugash '196 claim 1 and 2 combinations of a main frame member (orange), parallel rule linkage means (green), platform supporting member (yellow), hinged mounting of a platform (blue) to the platform supporting member (yellow) and power means (brown) are all found in both the Novotney '403 reference [Exs. AN-2, 3] and the claimed subject matter of Lugash '227 [Ex. AN-1]. In this old combination of old elements, the specific positioning of the power cylinder, electric motor, hydraulic fluid pump, fluid supply source and hydraulic connections all on the main frame member (orange) rather than on the other parts of the vehicle are obvious modifications within that old combination suggested by any of the prior art Messick, Wachter or Wood patents.

The combination of elements of claim 4 are shown to be an old combination claimed in Lugash '227 in each of Exhibits AN-4, 5 and 6. The old combination and complete anticipation of the unitary construction of Lugash '196 claim 6 by any of the prior art Messick, Wood or combination of Vogel and Spitler references are shown in Exhibits AN-9, AN-10 and AN-11.

The Lugash '196 claims define an old combination in which each of the elements continues to perform its old function in the old combination.

“We summarize what we conceive to be the now exacting rule laid down in the A. & P. Tea case. There the court cites with approval its former de-

cision in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, wherein it said: ‘the mere aggregation of a number of old parts or elements which, *in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them* (the old parts), is not patentable invention.’

* * *

“From the foregoing language we must and do assume that the court was simply saying that where a mechanical combination device represents only an integration of various old elements and the combination clearly reveals that its old elements thus brought into conjunction or correct do not *functionally operate differently therein* than they did before integration, then it is not a patentable invention. In other words, this sort of an integration does not add to the sum of useful knowledge or to the total stock of knowledge and the expert mechanical skill employed in creating it has not made the device ‘exceed the sum of its parts.’ If the evidence clearly establishes that the device is of the type just above described, it obviously lacks the quality of invention. In that event a trial judge is justified, as a matter of law, in directing a jury to return a verdict against patentability. And this rule applies regardless of the scope and breadth of the claims of such a patent, because patent claims may not override such established physical facts.” (Emphasis added).

Berkeley Pump Company v. Jacuzzi Bros., Inc.
(9th Cir., 1954), 214 F. 2d 785, 787, fn. 2.

There is no new result nor novel combination in Lugash '196. Finding 33 and the rule in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, support the District Court's Conclusion of Law G that the Lugash '196 patent claims are invalid because they are merely a combination of old elements in which such old elements perform no new, novel or unusual functions in the combination that they did not previously perform in the prior art [Concl. of Law G, Vol. I, p. 674].

"In the Kwikset Locks case, *supra*, 210 F.2d at page 486, we pointed out that, in *Atlantic & Pacific*, *supra*, 'the Supreme Court further requires that in order for a combination patent to be upheld, there must be a specific finding that the old elements which make up this device perform an additional and different function in combination, than they perform out of it.'

"As in Kwikset Locks, 'no such finding was made in the case at bar.' Regardless of any other defect, such a lack makes it impossible for the present decree to be sustained."

Bergman v. Aluminum Lock Shingle Corp. of America (9th Cir., 1957), 251 F. 2d 801, 808.

In this case, the District Court not only did not fail to make a finding of new and different functions for the claim elements in the combination as required by this Court for patent validity in the *Bergman* case, *supra*, it specifically found that each of the old elements does *not* perform any new or different function in the combination not previously performed by them in the prior art [Find. of Fact 33, Vol. I, p. 671].

VII.

The District Court Correctly Found the '196
Combination of Old Elements Invalid.

Plaintiffs admit that the various elements in Lugash '196 do not perform any new functions in the claimed combinations not previously performed by them in the prior art (Op. Br. of Cross App. p. 17). The correctness of the District Court's Finding 33 to this effect is not disputed but, plaintiffs assert that the Finding is insufficient to hold the claims invalid under this Court's theory in *Pursche v. Atlas Scraper and Engineering Co.* (9th Cir., 1962), 300 F. 2d 467 (Op. Br. of Cross App. pp. 15-21).

In the *Pursche* case, *supra*, the District Court had specifically found as to the '090 patent claims held valid that:

“* * * the elements of the plow share carrier rotating device ‘performs an additional and different function in combination than they perform out of combination.’”

Pursche v. Atlas Scraper and Engineering Co.,
supra, page 472.

But as to other claims of the '090 patent:

“‘it is not necessary that all of the elements of the claim be found in one prior patent. If they are all found in different prior patents and no new functional relationship arises from the combination, the claim cannot be sustained.’ *Eagle v. P. & C. Hand Forged Tool Co.*, 74 F.2d 918, 920 (9th Cir. 1935).

“Since no new function nor any surprising or unusual circumstances would arise from placing the Unterilp tail wheel on the plow described in the

Capon patent, we conclude that claims * * * of the '090 patent are invalid for they merely recite what already existed in the prior art."

Pursche v. Atlas Scrapper and Engineering Co.,
supra, page 475.

There is no different rule of law in the *Pursche* case, *supra*, from that of *Lincoln Engineering, supra*. The same test was applied in both. However, contrary to the factual finding of a new function for some of the old elements in the '090 patent claims by the District Court in *Pursche, supra*, the District Court here has correctly found that there are no new functions for the old elements of Lugash '196 [Undisputed Find. of Fact 33, Vol. I, p. 671; Concl. of Law G, Vol. I, p. 674].

The provision of a main frame upon which all associated parts are mounted in the '196 loader does not produce any new function or surprising or unexpected consequences for any of the old elements found in '196. The District Court correctly applied the rule of *Lincoln Engineering* that:

"* * * The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

Lincoln Engineering Co. v. Stewart-Warner Corp., *supra*, 303 U.S. at 549-550,

and found '196 invalid upon the undisputed factual finding [Find. of Fact 33].

The claims of the Lugash '196 patent, as readily seen from an examination of defendant's Exhibit AN, are merely an aggregation of a number of old parts or ele-

ments [main frame, platform, linkage, hydraulic cylinder and piston means, reservoir, pump, motor, switch, conduits, manual valve, platform supporting member, hinge and stop; claim 4, Exh. 2] each of which continues to perform its same old function and operation in the combination as that performed out of it.

This Court has repeatedly held such combinations of old elements invalid:

“Here the spring gripped the male insert, springs had thus functioned before. S-springs functioned to produce a greater area of contact with the insert. They had so functioned, to a greater or lesser degree, in the prior art. * * * This was, at best, an improvement in efficiency of function, but not the creation of a new, different or additional function, or a new or different result. It was not unexpected. It was at best the ‘mincing step forward’ described in 69 C.J.S. Patents §§ 204, 213, pp. 686-87, 726-27.”

Continental Connector Corp. v. Houston Fearless Corp. (9th Cir., 1965), 350 F. 2d 183, 191.

“The A. & P. case sets forth a test for determining whether or not there has been invention when there is a conjunction of known elements: the unification of the elements must result in unusual or surprising consequences; the old elements which make up the device must perform some additional or different function * * *.”

Dresser Industries, Inc. v. Smith-Blair, Inc. (9th Cir., 1963), 322 F. 2d 878, 889.

“Whether River’s contribution is of sufficient novelty to be patentable is therefore a question of law, based upon the rule that a combination of old elements is patentable invention only if the elements take on some new quality or function by being brought into concert and their combination results in unusual or surprising consequences.”

Farr Co. v. American Air Filter Co., Inc. (9th Cir., 1963), 318 F. 2d 500, 502.

“* * * As in the case of other combinations of ideas drawn from existing knowledge, the old elements, including the known material in the new use, must perform additional and different functions in the combination than out of it; the results must be unusual and surprising—more must be derived from the combination than that which might be reasonably expected as the sum of the old ideas drawn from the public domain.”

Griffith Rubber Mills v. Hoffar (9th Cir., 1963), 313 F. 2d 1, 4.

“Applying the test of the A. & P. case to the uncontroverted facts before us here, we hold that the Trial Court did not err in concluding that the George device is a non-patentable aggregation of old components and therefore invalid. Its components do not perform any additional or different function in the combination than they perform out of it.”

William T. Alvarado Sales Co. v. Rubaloff (9th Cir., 1959), 263 F. 2d 926, 930.

VIII.

Findings of Fact 34-35a Are Supported by the Evidence: '196 Is an Obvious Variant of '227 in View of the Prior Art.

Plaintiffs fail to support their bare allegation that Findings of Fact 34 to 35a are clearly erroneous. The District Court's Findings of Fact 34 through 35a are supported by substantial evidence presented at trial.

Plaintiffs concede that the Trial Court correctly recognized that to be valid, Lugash '196 must be a distinct patentable advance over what was claimed in Lugash '227 (Op. Br. of Cross App. pp. 6-7). Plaintiffs attempt to rely upon Finding of Fact 8 [Vol. I, p. 664] as demonstrating the claimed subject matter of Lugash '227, claim 8 conveniently omitting any reference to a frame structure (supposedly the additional element providing a new unitary combination in Lugash '196). However, as shown in defendant's Exhibit AN, the combination of platform, power means, frame structure, parallel rule linkage systems and hinged connections for allowing folding of the platform are all old elements in an old combination as to Lugash '196 because actually claimed in the prior Lugash '227 patent claims [Exs. AN-1, 5, 6, 7 and 8; Gabriel, Vol. III, pp. 734-748, Vol. I, pp. 289-309].

The District Court found the unitary construction (not claimed in '227) of Lugash '196 to be old in powered loaders as demonstrated by the prior Messick, Wood and other patents [Exs. C, D] as well as the defendant's own power loaders made and sold prior to Lugash '196 [Undisputed Find. of Fact 32, Vol. I, p. 671].

The folding concept in Lugash '196 was claimed in the '227 patent and therefore is not of patentable significance in the '196 patent. The claims of the '196 patent merely incorporate the claimed subject matter of Lugash '227 in combination with other disclosures of the prior art as exemplified by defendant's Exhibits AN-1, AN-4, AN-5, AN-7 and AN-8 [Find. of Fact 34, Vol. I, pp. 671-672; Gabriel, Vol. I, pp. 289-309, Vol. III, pp. 734-748] The District Court correctly concluded that the Lugash patent '196, including the problem of platform clearing the hydraulic cylinder piston, is a variant of the claimed subject matter of Lugash '227 which would be obvious to one skilled in the art [Find. of Fact 35a, Vol. I, p. 672; Vogel, Vol. III, pp. 422-432, 442-445, 446-450, 456, 473, 476-480; Gabriel, Vol. III, pp. 658, 664, 734-748, 833-835].

Plaintiffs only assert that the Trial Court should have reached a different conclusion because of a supposed misapplication of the prior ruling of this Court in *Intricate Metal Products, Inc. v. Schneider* (9th Cir., 1963), 324 F. 2d 555 (Op. Br. of Cross App. pp. 22-30). This Court stated in the *Intricate Metal* case, *supra*, with respect to patents issued to the same inventor wherein the applications were copending before the Patent Office that:

"The first patent does constitute a prior art reference as to what it claimed. The significance of the fact that No. 690 was pending when No. 490 was filed is simply that the inventive advance of 490 must be over what was claimed in the 690 application and need not be over the totality of its disclosure as would otherwise be the case."

Intricate Metal Products, Inc v. Schneider, supra,
page 560.

Plaintiffs have admitted that the District Court probably recognized this requirement:

“The Trial Court recognized that the patentable advance of Lugash’s improvement patent would have to be over only what was claimed in his copending generic patent and need not be over the totality of its disclosure as would be the case if the patents were not copending.” (Op. Br. of Cross App. pp. 6-7).

This Court in the *Intricate Metal* case, *supra*, went on to state:

“In the case before us, No. 490 does not claim unpatented disclosures of No. 690. Rather, *it incorporates the claims of the earlier patent in combination with the other disclosures of prior art.* * * *, no one could manufacture the 490 sofa bed without infringing No. 690. * * *

“We conclude that patent No. 490 is invalid for lack of invention. . . .” (Emphasis added).

Intricate Metal Products, Inc. v. Schneider, supra, page 561.

The District Court did not misapply the *Intricate Metal* case. It correctly followed the advisement of this Court in holding the Lugash ’196 patent invalid because it found as a matter of *Fact* that:

“The claims of patent ’196 incorporate the claims of Lugash ’227 in combination with other disclosures of prior art, as exemplified by defendant’s Exhs. AN-1, AN-4, AN-5, AN-7 and AN-8.” [Find. of Fact 34, Vol. I, pp. 671-672].

The District Court concluded that the “other disclosures of prior art” in addition to the “claimed subject matter”

of the former '227 patent rendered the second patent invalid. While plaintiffs urge a supposed clearance problem, it is apparent that the District Court considered this in its decision and found to the contrary in stating:

“The folding platform was claimed in Lugash patent '227. It appears that Lugash patent '196, *including the problem of the platform clearing the hydraulic cylinder piston*, is a variant of the claimed subject matter of Lugash '227 which would be obvious to one skilled in the art.” [Emphasis added; Find. of Fact 35a, Vol. I, p. 672].

Plaintiffs contradict themselves attempting to allege error in the District Court in applying the *Intricate Metal Products'* case to the facts of this action. Plaintiffs admit that the District Court correctly recognized the *Intricate Metal Products'* rule (Op. Br. of Cross App. pp. 6-7). The District Court did not ignore the supposed clearance problem [Find. of Fact 35a] and plaintiffs fail to show that there is no evidence to support the Court's conclusion that notwithstanding such alleged problem, the '196 patent is merely an obvious variant over the claimed subject matter of Lugash '227. Plaintiffs' argument again reduces merely to the verbiage of placing the old combination of unitary hydraulically powered load elevator “any place under the truck” (Op. Br. of Cross App. p. 25). The District Court was fully advised as to the unitary construction of plaintiffs' loader [Undisputed Find. of Fact 31]. The Trial Court found and plaintiffs do not dispute that there is no difference in the problem of unitary construction in the plaintiffs' device and that disclosed in the loaders of the prior art patents and the defendant's own prior models [Undisputed Find. of Fact 33].

Findings of Fact 34 through 35a are supported by more than substantial evidence and compel the legal conclusion that the '196 patent is invalid "because it attempts to claim the claimed subject matter of the prior Lugash patent '227 in combination with other disclosures of the prior art" [Concl. of Law G, Vol. I, p. 674; *Intricate Metal Products, Inc. v. Schneider, supra*, p. 561].

The Presumption of Validity Was Overcome by the Non-Cited Prior Art Unitary Power Loaders.

It is admitted that the Patent Office did not have a reference before it which showed the claimed unitary construction of the '196 patent wherein all components including the electric motor, hydraulic pump and fluid reservoir, are also mounted on a main frame member (Op. Br. of Cross App. pp. 31-32). This so-called unitary construction was asserted to the Patent Office by the patentee as a basis for issuing the '196 patent and is the only real structural difference in '196 over the claimed subject matter of '227 [Ex. 2, Col. 3, lines 45-49; Gabriel, Vol. III, pp. 649-651; Comstock, Vol. III, p. 252; Ex. AN].

"To make the nature of the invention sought to be protected still more clear, the specification has been slightly amended to point out that applicant's invention relates to a device which is attachable to a vehicle as a unit as distinguished from the prior art structures in which, so far as the cited references are concerned, includes devices which must be attached to the vehicle at numerous separated points." [Ex. B, pp. 18-19].

". . . applicant's device is a unit in which all associated working parts are mounted on a main frame member and therefore the operating align-

ment of the various parts is accurately preserved.” [Ex. B, p. 19].

“It is believed that the Examiner has misconstrued the disclosures of applicant’s prior patent and Ornsby. Neither of these patents show the unitary structure alleged.” [Ex. B, p. 22].

“... the claims have been amended to stress this unitary type of construction and, as pointed out above, this unit construction is not to be derived from either applied reference nor from any combination of them.” [Ex. B, p. 22].

None of the references relied upon by the Patent Office in acting on the ’196 patent [Ex. 2: Narvestad ’529, Wood ’135, Ornsby ’938, Lugash ’227 and Roberts ’187, Exs. C, D] disclosed or claimed a power loader for vehicles which could be mounted to the vehicle chassis by a single main frame member.

“... It is crystal-clear that after the first rejection, Scroggin relied entirely upon the sealing arrangement as the exclusive patentable difference in his combination. It is likewise clear that it was on that feature that the Examiner allowed the claims.

* * *

“Here, the patentee obtained his patent only by accepting the limitations imposed by the Examiner. The claims were carefully drafted to reflect these limitations and Cook Chemical is not now free to assert a broader view of Scroggin’s invention. The subject matter as a whole reduces, then, to the distinguishing features clearly incorporated into the claims.”

Graham v. John Deere Company of Kansas City, supra, 86 S. Ct. at 30, 32.

The Patent Office did not have the best prior art before it. However, the District Court was well-advised as to the state of the prior art including the prior Messick '193, Wood '540, Wachter, Duis and Park patents [Exs. C, D] and *defendant's own prior unitary loaders* [Find. of Fact 32]:

"It will be observed that the whole assembly, including the hangers, motor, fluid supply lines, platform and the actuating arms and the links are all carried by the torque tube 7 and thus may be assembled at the factory and placed into position on the truck by the mere application of the tie rods or bolts 10. This, as before stated, avoids the necessity of a great deal of laborious work made necessary where the truck frame has to be drilled to receive special fittings." [Messick, Ex. C, Col. 3, lines 18-26].

". . . this invention provides a self-contained power actuated tailgate unit attachable to the open rear end of the box body, the unit comprising all operating components and accessories, to wit, a tailgate or platform, an elevation mechanism or parallel motion device for the platform, a hydraulic operating system for the elevating mechanism complete with pump, power cylinder means, pressure oil lines, oil reservoir and a manually operable control valve unit, and further more significantly, an electric motor for driving the pump. . . ." [Wood '540, Ex. C, Col. 2, line 7 *et seq.*].

In view of these prior unitary construction loaders, the presumption of patent validity as to the Lugash '196 patent in suit was clearly overcome.

“Even one prior art reference which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated. Such is the case here.”

Jacuzzi Bros. Inc. v. Berkeley Pump Co. (9th Cir., 1951), 191 F. 2d 632, 634, fn. 4, page 637.

Claim 6 of '196 May Not Be Rewritten Contrary to the Patentee's Interpretations Thereof Before the Patent Office.

Plaintiffs attempt to rewrite claim 6 of the '196 patent to include the folding concept not expressed therein. Even assuming that this would be proper (which it is not), the District Court's conclusion of invalidity for the '196 patent previously discussed would not be affected. The District Court found all claims in issue invalid, including claims similar to plaintiffs' proposed modification of claim 6.

Claim 6 merely recites a unitary powered load elevator completely anticipated by Messick '923 [Ex. AN-9], Wood '540 [Ex. AN-10] and defendant's own prior unitary EB-1200 and EB-1500 loaders [Exs. N-X]. Claim 6 is an embarrassment to plaintiffs because its broad claiming of a unitary construction in any type of power loader emphasizes that it was this single allegedly distinguishing feature of unitary construction which caused the allowance of the '196 patent by the Patent Office. There was no inadvertent omission of the folding concept from claim 6 of Lugash '196. The second object of the patent is specifically directed to a broad unitary power loader, the patentee stating:

“Another object of the invention is to provide a platform type hoisting apparatus attachable as a unit to loader trucks or light vehicles including hydraulically actuated means for lifting the platform and in which the power means is mounted on the main frame member for the hoist whereby the entire hoist and its power unit form a complete assembly or unit for attachment to the vehicle.” [Ex. 2, Col. 1, lines 22-28].

When the Patent Office failed to find any reference which showed a unitary construction for a power loader, the patentee added claim 6 (application claim 9) by an amendment dated November 16, 1959 [Ex. B, p. 22]. After pointing out that no cited reference disclosed or claimed a unitary construction, the patentee expressly interpreted the newly added claim as follows:

“New claim 9 is presented as a broader expression of the invention above described, it being believed to be self-evident from the nature of the cited references, as above discussed, that applicant is entitled to a claim at least as broad as this new claim 9. It is specifically directed to the unitary structure comprising the main frame which supports *all* the components of the device and the components other than the main frame are believed to have been recited in this claim in sufficient particularity to constitute an operative whole.” [Ex. B, p. 23].

The patentee expressly stated to the Patent Office that the issue claim 6 was a “broader expression” of the alleged unitary construction invention. The distinguishing feature was asserted to be that the unitary construction included a main frame member which sup-

ported “*all* the components of the device”. Significantly, the patentee’s statement shows that the folding concept was deliberately left out of claim 6 because it was believed that the other elements recited constituted an “operative whole” without the folding concept. The patentee’s contentions that there was no unitary construction in the prior art to anticipate this application claim 9 was repeated in subsequent remarks [Ex. B, p. 27] and the patent was allowed [Ex. B, p. 29].

Claim 6 of Lugash ’196 was thus presented to the Patent Office as being a broader statement of the alleged unitary construction invention and asserted to claim an operative whole. Such was not the case in *United States v. Adams*, U.S., 86 S. Ct. 708 (1966). In *Adams, supra*, the electrolyte not referred to in the claims was a *necessary* element to the claimed battery (86 S. Ct. at 713). In Lugash, the folding concept is not a necessary element. In fact, the patentee asserted the direct opposite to the Patent Office in stating that the unitary power loader claimed was an “operative whole”. Also, Adams had uniformly asserted that the missing necessary element was a water electrolyte:

“In his first contact with the government less than a month after the patent application was filed, Adams pointed out that ‘no acids, alkaline or any other liquid other than plain water is used in his cell. Water does not have to be distilled. . . .’”

United States v. Adams, supra, 86 S. Ct. at 713.

Further, in *Adams, supra*, the District Court had found and the government apparently *admitted* on appeal that the Adams’ battery obtained a “wholly unexpected” result (86 S. Ct. at 714). Here, the asserted

distinguishing features of a unitary construction in a folding platform loader do not produce any unexpected results but are merely the expected, obvious result of combining the admittedly old elements. Claim 6 fails to define a patentable advance over the art and cannot be saved by reference to the specification or other claims.

“As none of the flywheel claims as drawn define an invention, none can be aided by reading into it part of the specification, or of other claims, which the patentees failed to include in it.”

Altoona Publix Theaters, Inc. v. American Try-Ergon Corporation, 394 U.S. 477 (1935).

Claim 6 was deliberately broadly written by the patentee to cover all unitary power loaders and plaintiffs have, through Patent Office error, had the benefit since June 20, 1961 (the date of issuance of '196) of this improperly broad patent claim to the detriment and disadvantage of the public. Plaintiffs have not heretofore attempted to correct claim 6 by petitioning the Commissioner of Patents to narrow its scope. Instead, plaintiffs have taken advantage of the claim in notifying the public of their patent and in asserting it against defendant. Plaintiffs should not now be allowed to rewrite the claim to include new elements never intended to be included within the claim.

“Here claim I did not claim four wheels or rollers while other claims did. Other claims should not be read into claim 1.”

Stearns v. Tinker & Rasor, 252 F. 2d 589, 597 (C.A. 9, 1957).

“It appears to us that the limitation of claim 1 by the trial court to a tubular or enclosed guide is contrary to the well established rule of construction that a broad claim will not be construed to contain limitations expressed in the more narrow claims. *Smith v. Snow* (1935), 294 U.S. 1; *Stearns v. Tinker and Rasor*, (9th Cir. 1957), 252 F.2d 589; *Cameron Iron Works, Inc. v. Stekoll* (5th Cir. 1957) 242 F. 2d 17; *Great Lake Equipment Co. v. Fluid Systems, Inc.* (6th Cir. 1954), 217 F.2d 613.”

Hansen v. Colliver, 282 F. 2d 66 (C.A. 9, 1960).

Conclusion.

The District Court's conclusion of invalidity for the '196 patent was compelled by the prior state of the load lifter art, the testimony of the experts and the high standard of patentability applied by the courts. The admittedly lower standard applied by the Patent Office and its failure to consider the more pertinent prior unitary loader constructions before the District Court overcome any statutory presumption of validity. *Lugash '196* is merely an obvious adaptation of old unitary constructions of prior powered loaders in the old combination previously claimed in the '227 patent. There is no unexpected result. The progress of science is not promoted.

The District Court considered the asserted “clearance problem” of '196 and plaintiffs' allegation of a new result by a new combination, but correctly found to the contrary. It made no reversible error in fact or law. The '196 patent is invalid because the unitary or main

frame construction adopted by '196 was old in the art; there is no substantial difference in making powered loaders for vehicles unitary whether the load carrying platform folds down, out, up or over; '196 attempts to monopolize a combination of old elements which perform no new or unusual functions in combination; '196 claims the same old combination of elements claimed in the prior '227 patent with an obvious modification or alleged improvement in the main frame element; and because the '196 claims incorporate the claimed subject matter of '227 in combination with other disclosures of the prior art in a variant over '227 which is obvious to those skilled in the art.

Defendant was making powered loaders for vehicles long prior to plaintiffs and had adopted the prior well-known unitary construction for its loaders to allow ease of installation on vehicles, whether at defendant's plant or out in the field. Defendant's only modification of its admittedly old, prior art, non-patented construction of loader was to adopt the old folding platform concept of any of the Narvestad, Jester or Peters patents to facilitate dock loading. This prior folding concept to allow dock loading of powered truck loaders was part of the prior art freely available to those persons skilled in the art to adopt and use.

Defendant has the right to make use of prior art concepts and construction taught by prior patents whether they were ever in fact commercially used before or not. It cannot be held to infringe either of plaintiffs' patents which were issued by Patent Examiners who were unaware of the true state of the art and applied an admittedly low standard of invention. Defendant's prior art unitary truck loaders employing the

prior art folding platform cannot be held to infringe later conceived patents. The District Court's conclusion of invalidity as to the '196 patent should be affirmed.

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Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those Rules.

GUY PORTER SMITH

